

Notice of Allowability

Application No.

09/613,535

Applicant(s)

MURPHY ET AL.

Examiner

Art Unit

Cynthia B. Wilder, Ph.D.

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/14/2005.
2. ☒ The allowed claim(s) is/are 9,12-16,18,19,22-29 and 31-47.
3. ☒ The drawings filed on 10 July 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 4/2/05
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

REASONS FOR ALLOWANCE

1. Applicant's amendment filed on February 14, 2005 is acknowledged and has been entered. Claims 9, 12, 13, 16, 18, 22, 23, 24, and 26 have been amended. Claims 1-8, 10-11, 17, 20-21, 30, 48-57 have been canceled. Claims 9, 12-16, 18, 19, 22-29, 31-47 are pending. Applicant's amendments and submission of a Declaration under 37 CFR 1.132 place claims 9, 12-16, 18, 19, 22-29, and 31-47 in condition for allowance.

Declaration under 35 USC 1.131

2. The declaration filed on February 7, 2005 is acknowledged and has been considered. However, the declaration is ineffective to overcome Carr et al patent because no Exhibit 1 or evidence has been submitted to establish reduction to practice prior to the patent of Carr et al. Applicant relies on information from an Exhibit that has not been found in the instant application. The prior of Carr et al has been withdrawn based on Applicant's amendments to the claims, which clarifies the scope of the invention.

Examiner's Amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mark Wilson on April 27, 2005.

The application has been amended as follows:

- (a) In claim 23 at line 1, a --9-- was inserted after "claim".

Reasons for Allowance

3. The following is an examiner's statement of reasons for allowance: Applicant's amendments and declaration submitted under 37 CFR 1.132 are sufficient to overcome the prior art rejections. The declaration by the Expert under 37 CFR 1.132 establish that the claims require that the extended nucleic acid have essentially identical 5' ends and variable 3' ends which is not taught in the prior art. Likewise the reference establishes that the limitation as recited at step (d) of claim 9 is not taught in the prior art of Short et al. The declaration establishes that while the reference of Short et al teaches "a chain terminating agent", the reference does not teach wherein the "chain terminating agent" is a "dideoxynucleotide or a dideoxynucleotide comprising a nucleotide analog that is incorporated into the extended nucleic acid. Moreso, the declaration establishes that the prior art of Short does not teach or suggest, "modifying or removing the dideoxynucleotide or dideoxynucleotide comprising a nucleotide analog from the first extended nucleic acids". The prior art does not teach or suggest these essential steps. Allowability is based in the combination of methods steps recited therein.

4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail.

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Alternatively, a request for a return telephone call may be emailed to cynthia.wilder@uspto.gov.


Since email communications may not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

4/27/05